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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,247	01/22/2002	Mark Ellery Ogram	1475B.5A.4	9185

7590 09/02/2003
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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,247

Applicant(s)

OGRAM, MARK ELLERY

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
 2. The disclosure is objected to because of the following informalities:
 - A) applicant must update:
 - (1) the continuing data on page 1;
with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.
 - B) The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See applicant's use of web address in:
 - (1) the paragraph at page 7, lines 15-18, "By selective use of the URL ... is: <http://merchant.com.widget>."; and
 - (2) the paragraph at page 7, lines 19-22, "When the merchant is selling ... is: <http://merchant.com.widget/blue>."
- Hence, applicant should delete the http:// from page 7, lines 18 & 22.
- Appropriate correction is required.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
 4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.1 The specification is objected to under 35 U.S.C. § 112, first paragraph, as:

A) the specification, as originally filed, does not provide support for the invention as now claimed.

4.1.1 In the amendment filed July 10, 2003, applicant amended claims 1, 5 & 9 to include the phrase “which is unmolested by said merchant computer”, however, the use of the word “unmolested” in this phrase is not supported by the disclosure as originally filed.

4.1.2 In this regard the word unmolested means without “annoying, disturbing, or persecuting especially with hostile intent or injurious effect”, however as disclosed the claimed system operates as follows:

A) as seen in fig. 2A and disclosed in the paragraph at page 13, lines 2-7, “Referring to figure 2A, ... network 20 to customer computer 21.”, the user at customer computer 21 browses a number of merchant computers 22.

B) when the user wishes to purchase something, then as seen in fig. 2B and disclosed in the paragraphs between page 13, line 8, and page 14, line 9, “When the consumer decides ... which is to be debited the amount of the product.”, the user at customer computer 21 is connected to payment computer 23 and send the payment/account information to the payment computer 23. Payment computer then uses the characteristics of network operation to obtain the URL assigned to the merchant computer and product without connecting to the merchant computer 22.

C) after obtaining the required information as seen in fig. 2C and disclosed in the paragraph at page 14, lines 10-17, “As shown in figure 2C, ... authorization indicia gives the acceptance or denial of the charge.”, and the payment computer 23 formulates a request for authorizing the payment, sends the request to computer 24 and waits for an authorization indicia.

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D) after receiving the authorization indicia, as seen in figs. 2D & 2E and disclosed in the paragraphs between page 14, line 18, and page 15, line 24, "If a product is to be shipped, ... funds paid for his product/service provided to the consumer.", the payment computer 23 either directs the merchant computer 22 ship the purchased item to the consumer or reconnects the customer's computer 21 to the merchant computer 22 at an appropriate location based on the authorization indicia.

Although it is true as disclosed that the merchant does not handle the consumer's account information, applicant's use of the word "unmolested" in claims 1, 5 & 9 as this word is commonly understood by one of ordinary skill does not filed adequate support with in the disclosure as originally filed. There for the amendment filed July 10, 2003 introduces new matter.

4.1.3 Claims 1-11 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

5. Claims 1-11 are provisionally rejected under the judicially created doctrine of double patenting over:

A) claims 1-5 & 7-10 of copending Application No. 09/400,724; or

B) claims 1-13 of copending Application No. 09/654,339.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5.1. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A) a computer network;

B) a merchant computer, which perform the same functions in either the patents or applications; and

C) a financial/settlement/payment computer, which perform the same functions in either the patents or applications.

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5.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(102(e) only) The changes made to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. § 122(b). Therefore, this application is examined under 35 U.S.C. § 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

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6.1 Claims 1-11 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either Payne et al (5,715,314 or 5,909,492).

6.1.1 In regard to claims 1-11, either Payne et al ('314 or '492), disclose a payment/settlement system in which an user at a consumer computer communicates via a computer network with a merchant computer. When the user wishes to purchase an item, the consumer computer communicates payment information for user's order to a remotely located payment processing center via the network. The payment processing center then requests an authorization indicia from a financial processing computer. Once the payment processing computer receives the authorization indicia, the payment processing computer sends an indication of the authorization to the merchant. Once the indication of the authorization has been received by the merchant, the merchant releases the ordered items to the customer based on the procedure established by the terms of the transaction.

7. Response to applicant's arguments.

7.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

7.2 As per the objection to the disclosure, since:

A) applicant failed to explicitly request that the substitute pages filed July 10, 2003 replace the originally filed pages, the requested corrections have not been made. Hence, applicant's argument's are non persuasive. It is noted that the proposed corrections filed July 10, 2002 would overcome the objections to the disclosure, if they had been entered.

7.3 As per the provisional double patenting rejection, since in response to this rejection must do one of the following:

- A) cancel the conflicting claims; or
- B) must amend the conflicting claims so that the conflicting claims do not have the same claimed subject matter; or
- C) file a terminal disclaimer (provisional double patenting only); or
- D) abandon the application so that the conflicting claims are no longer pending.

Hence, whenever a double patenting rejection is made whether the it is a statutory or provisional double patenting, then applicant is required to appropriately address this rejection

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in applicant's next response. Since applicant failed to appropriately address the provisional double patenting rejection, applicant's argument's are non persuasive.

7.4 As per the 35 U.S.C. § 102 rejection, since:

A) in either Payne et al (5,715,314 or 5,909,492) the user send the payment information to the payment processing computer without intervention by the merchant, applicant's argument's are non persuasive.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

08/27/03


Edward R. Cosimano
Primary Examiner A.U. 3629